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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055558
Party	Defendant Emmmanouil Kokologiannis and Sons, Societe Anonyme of Trade, Hotels And Tourism S.A. "with the business title "Scala" "Pangosmio"
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ECONOMY RENT-A-CAR INC., Petitioner, v. EMMANOUIL KOKOLOGIANNIS AND SONS, SOCIETE ANONYME OF TRADE, HOTELS AND TOURISM S.A., Respondent.	Cancellation No. 92055558 Registration No. 3256667

RESPONDENT'S MOTION TO REOPEN THE PERIOD TO SERVE PRETRIAL DISCLOSURES

Respondent, Emmanouil Kokologiannis and Sons, Societe Anonyme of Trade, Hotels and Tourism S.A. ("Respondent"), through its attorneys Leason Ellis LLP, pursuant to Fed. R. Civ. P. 26(a)(1)(A)(i) and 26(e)(1)(A), C.F.R. § 2.121(e), and TBMP § 702.01, hereby moves to reopen the period to serve Pretrial Disclosures so that it may amend its Pretrial Disclosures to identify two additional trial witnesses.

I. INTRODUCTION

On February 18, 2015, Respondent filed a motion to extend all remaining deadlines in this cancellation action by thirty days. Dkt. 48. During a telephone conference between counsel for the parties and the Board on February 24, 2015, Petitioner objected to Respondent's service of amended Pretrial Disclosures three days earlier.[1] Petitioner alleged that counsel for the parties had agreed to a prior extension of dates under the condition that Respondent not seek an extension of its deadline to serve Pretrial Disclosures. Polidoro Dec. at ¶2.

Respondent did not seek an extension of time to serve its Pretrial Disclosures. They were

timely served on the December 20, 2014 deadline. Polidoro Dec. ¶3. On February 18, 2015, before its trial period opened, Respondent amended its Pretrial Disclosures to identify just two additional witnesses, Ioanna Myridaki and Micael Wäxby. Dkt. 49.

Respondent respectfully requests that the Board reopen the period for Respondent to amend its Pretrial Disclosures so that it may do so. The sum and substance of the testimony of the two additional witnesses had been identified during the discovery period. There is substantial justification for allowing amendment of Respondent's Pretrial Disclosures in order to allow those witnesses to testify. Furthermore, amendment of the Pretrial Disclosures prior to the opening of Respondent's trial testimony period is harmless, so there is no prejudice to Petitioner.

II. ARGUMENT

i. The Legal Standard

The Trademark Board Manual of Procedure for the most part defers governance of Pretrial Disclosures to the Federal Rules of Civil Procedure. TBMP § 702.01. The purpose of providing each side with pretrial disclosures is to "allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses. *Id*.

Unlike the FRCP, the TBMP contemplates that due dates for pretrial disclosures will be different for each party due to alternating testimony periods, but notes that they must be served no later than fifteen days prior to the opening of each testimony period. TBMP §702; 37 CFR § 2.121(e). Disclosure of witnesses should consist of the name and, if not previously provided, the telephone number and address of each witness from whom each party intends to take testimony. *Id.*; Fed. R. Civ. P. 26(a)(1)(A)(i).

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[1] *See* Declaration of Victoria T. Polidoro ("Polidoro Dec.") at ¶1.

Under the FRCP, the party filing its disclosures is under an ongoing duty to "supplement or correct its disclosure or response…in a timely manner if the party learns that in some material respect the disclosure or response is incomplete or incorrect, and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process in writing." Fed. R. Civ. P. 26(e)(1)(A).

"A party that without substantial justification fails to disclose information required by Rule 26(a) or 26(e)(1) shall not, unless such failure is harmless, be permitted to use as evidence at trial … any witness information not so disclosed." *Brighton Collectibles, Inc. v. Marc Chantal USA, Inc*., 06-CV-1584 H(POR), 2008 WL 4001066, at *1 (S.D. Cal. Aug. 28, 2008). The burden of proving "substantial justification" or "harmlessness" is on the moving party. *See Id*. (citing *Yeti by Molly Ltd. v. Deckers Outdoor Corp*., 259 F.3d 1101, 1106 (9th Cir. 2001)(citing *Wilson v. Bradlees of New England, Inc*., 250 F.3d 10, 21 (1st Cir. 2001).

ii. The Test Applied by the Board

The test applied by the Board in determining whether service of amended disclosures is harmless includes the weighing of five factors: "(1) the surprise to the party against whom the evidence would be offered; (2) the ability of that party to cure the surprise; (3) the extent to which allowing the testimony would disrupt trial; (4) importance of the evidence; and (5) the non-disclosing party's explanation for its failure to disclose the evidence." *Great Seats, Inc. v. Great Seats, Ltd*., 100 U.S.P.Q.2d 1323 (TTAB 2011)(*citing Southern States Rack & Fixture, Inc. v. Sherwin-Williams Co*., 318 F.3d 592, 597 (4th Cir. 2003).

In the *Great Seats* case, the Board imposed the most extreme sanction, preventing the non-disclosing party from taking testimony of its witnesses at trial, because Opposer served its pretrial disclosures one month after the close of discovery naming one potential witness, then seven months

after the close of discovery it served amended and supplemental pretrial disclosures naming twenty-six additional witnesses. *See Id*. The Board applied the estoppel sanction with regard to the twenty-six witnesses, but actually allowed the testimony of the one witness disclosed a month late in the original pretrial disclosures, "provided that applicant has an opportunity to take [the witness's] discovery deposition prior to his appearance for a testimony deposition." *Id*. at *5.

Various federal courts have applied similar tests to the one that was applied by the Board in *Great Seats* and have often found in favor of the disclosing party, holding that allowing parties who disclosed witnesses by way of an amended pretrial disclosure did not prejudice the other side and the delay to be harmless. *See Graham-Adams v. Omaha Hous. Auth.*, 805cv261, 2006 WL 3827431 at *2 (D. Neb. Dec. 28, 2006)("there is no evidence that [defendant] acted in bad faith or willfully disregarded the court's pretrial orders. The court thus refuses to prohibit [the witnesses] from testifying at trial"); *Brighton Collectibles, Inc. v. Marc Chantal USA, Inc*., 06-CV-1584 H(POR), 2008 WL 4001066, at *1 (S.D. Cal. Aug. 28, 2008)(the court refused to prevent five witness from testifying and re-opened the discovery period as to four, to allow their depositions to be taken prior to trial testimony).

iii. Application of the Law

Respondent never agreed not to amend its Pretrial Disclosures. Rather, it only agreed to serve its Pretrial Disclosures by the initial deadline. Polidoro Dec. at ¶2. The plain language of the correspondence between counsel confirms the same. The Board should look to the plain language of *Red Wing Co. v. J.M. Smucker Co.*, 59 U.S.P.Q.2d 1861 (TTAB 2001)(looking to the "plain language" of a proposed addendum to a protective order).

Absent an agreement not to amend its Pretrial Disclosures, the Board should look to the five factors in the *Great Seats* test to determine whether amendment is permissible (and, thus, whether

reopening of the time to serve Pretrial Disclosures is warranted). The factors and their analysis to the instant matter are as follows:

(1) The surprise of the party against whom the evidence is being offered. *Great Seat, Inc. v. Great Seats, Ltd., supra*. During the discovery period, Respondent produced documents and information about which both Mr. Wäxby and Ms. Myridaki will testify. Polidoro Dec. at ¶¶4,5. In fact, in response to Petitioner's document requests, Respondent produced a statement signed by Mr. Wäxby that relates to the testimony that he will give and two reports signed by Ms. Myridaki's supervisor that set forth the information about which she will testify. *Id.*

(2) The ability of that party to cure the surprise. *Great Seat, Inc. v. Great Seats, Ltd., supra*. No testimony dates have been set. Polidoro Dec. at ¶6. No cure is necessary as there is no surprise. Petitioner has ample time to prepare for Respondent's testimony under the current schedule. Additionally, Respondent has suggested pushing back all remaining deadlines in this action, which would enable Petitioner an additional thirty (30) days to prepare. Dkt. 48.

(3) The extent to which allowing the testimony would disrupt trial. *Great Seat, Inc. v. Great Seats, Ltd., supra*. Testimony dates have not yet been set and Respondent has requested the date for the close of its trial period be extended by thirty (30) days. Polidoro Dec. at ¶6; Dkt. 48. The addition of just two witnesses can hardly be expected to disrupt trial.

(4) Importance of the evidence. *Great Seat, Inc. v. Great Seats, Ltd., supra*. Petitioner alleges in its Petition for Cancellation that Respondent does not render services under its mark in the U.S. and that its alleged non-use in the U.S. equates to abandonment of the mark. Dkt. 1. Undertaking activities such as marketing with reasonable consistency of effort in the United States is sufficient to overcome a cancellation action for non-use or abandonment. *See General Mills, Inc. v. Frito-Lay, Inc.* 176 USPQ 148 (TTAB 1972).

The evidence that will be offered by Mr. Wäxby is necessary in order to provide understanding of Respondent's investments in database development, programming, software development, and web content infrastructures, which enabled Respondent to grow its U.S. customer base. Dkt. 49. Mr. Wäxby has unique personal and direct knowledge of the effort, time, specialized talent, and money devoted to these investments. *Id*.

The evidence that will be offered by Ms. Myridaki is important to demonstrate the amount of money spent by Respondent on advertising its services to U.S. customers, to provide quantitative information on the number of U.S. consumers exposed to Respondent's advertising, and to demonstrate the content of Respondent's advertising. *Id*. Ms. Myridaki will testify to documents and data that have been supplied by her employer, Google, as she is able to explain terminology contained in the reports and how to interpret the data. *Id*.

(5) The non-disclosing party's explanation for its failure to disclose the evidence. *Great Seat, Inc. v. Great Seats, Ltd*., *supra*. The reason these witnesses were not disclosed in the initial disclosures is due to Petitioner's own actions. Petitioner agreed to stipulate to a two-month extension of Respondent's trial period, resetting the date to March 4, 2015, yet insisted that Respondent serve its disclosures according to the former schedule, making them due on December 20, 2014, which was five days after the parties entered into the agreement, and three months prior to the opening of the testimony period. Polidoro Dec. at ¶2. In preparing its trial strategy and witnesses, Respondent has been working with parties who are located overseas. The scheduling of witnesses has required communications with foreign consulates in order to plan for their testimony and properly inform the witnesses before they would agree to testify.

III. CONCLUSION

Based on the foregoing, Respondent respectfully requests that the Board grant the instant motion to reopen the deadline for Respondent to serve its Pretrial Disclosures in order to afford Respondent the opportunity to amend its Pretrial Disclosures to identify Ioanna Myridaki and Micael Wäxby as trial witnesses.

Respectfully submitted,

Date: March 3, 2015
White Plains, New York

Peter S. Sloane
Victoria Polidoro

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **RESPONDENT'S MOTION TO AMEND ITS INITIAL DISCLOSURES** was served by First-Class mail, postage prepaid, upon the attorney for Petitioner, this 3rd day of March, 2015, addressed as follows:

Nicole M. Meyer, Esquire
Melissa Alcantara, Esquire
Samuel Littlepage, Esquire
DICKINSON WRIGHT PLLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ECONOMY RENT-A-CAR INC., Petitioner, v. EMMANOUIL KOKOLOGIANNIS AND SONS, SOCIETE ANONYME OF TRADE, HOTELS AND TOURISM S.A., Respondent.	Cancellation No. 92055558 Registration No. 3256667

DECLARATION OF VICTORIA T. POLIDORO IN SUPPORT OF RESPONDENT'S MOTION TO REOPEN THE PERIOD TO SERVE PRETRIAL DISCLOSURES

I, Victoria T. Polidoro, hereby declare and state as follows:

I am an Associate Attorney at Leason Ellis LLP, attorneys for Respondent. I submit this Declaration in opposition to Petitioner's motion to amend its initial disclosures. The facts stated herein are within my personal knowledge and are true to the best of my knowledge and belief.

1. Based on my review of the record, a telephone conference between counsel for the parties and the Board was held on February 24, 2015, during which service of Petitioner's Amended Pretrial Disclosures and a prior agreement between Respondent's previous counsel and Petitioner's counsel were discussed.

2. Based on my review of the record, as well as conversations with prior counsel confirming my understanding of same, Respondent's previous counsel entered into an agreement with Petitioner's counsel on December 12, 2014 which provided that, Petitioner's counsel would consent to a two-month extension of Respondent's trial period only if Respondent agreed to

serve its pretrial disclosures under the existing discovery schedule, the deadline for which was December 20, 2014.

3. Based on my review of the record, as well as conversations with prior counsel confirming my understanding of same, Respondent's Pretrial Disclosures were served on December 20, 2014.

4. Based on my review of the record, as well as conversations with prior counsel confirming my understanding of same, information regarding the topics of Mr. Wäxby's testimony as well as Mr. Wäxby's name were produced in response to Petitioner's Interrogatory No. 31 and Document Request Nos. 59 and 90.

5. Based on my review of the record, as well as conversations with prior counsel confirming my understanding of same, information regarding the topics of Ms. Myridaki's testimony were produced in response to Petitioner's Interrogatory Nos. 36, 37 and Document Request Nos. 7 and 53.

6. Based on my review of the record, as well as conversations with prior counsel confirming my understanding of same, no testimony dates have been set in this matter to date.

I hereby declare under penalty of perjury that the forgoing is true and correct to the best of my knowledge and belief.

Date: March 3, 2015

Victoria T. Polidoro

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **DECLARATION OF VICTORIA T. POLIDORO IN SUPPORT OF RESPONDENT'S MOTION TO REOPEN THE PERIOD TO SERVE PRETRIAL DISCLOSURES** was served by First-Class mail, postage prepaid, upon the attorney for Petitioner, this 3rd day of March, 2015, addressed as follows:

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Victoria T. Polidoro